

ASSIGNMENT

WHEREAS, DOUGLAS A. KIRKPATRICK, residing at 10929 Beach Mill Road, Great Falls, VA 22066, Assignor, has invented a new and useful invention entitled **BIOSENSOR FOR USE IN TOXICITY ASSESSMENT AND PHARMACOLOGICAL SCREENING** for which applications for United States Letters Utility Patent were filed by him bearing Serial Nos. 09/880,138 and 09/928,708, filed on June 12, 2001 and August 10, 2001, respectively, and executed by him on or about the same date as this Assignment; and

WHEREAS, Assignor believes himself to be an original, first and joint inventor of the invention disclosed and claimed in the applications for Letters Patent; and

WHEREAS, Science Applications International Corporation, having a place of business at 10260 Campus Point Drive, San Diego, California 92121, Assignee, desires to acquire by formal, recordable assignment the entire right, title and interest in and to the invention, the application, and any Letters Patent that might be granted for the invention in the United States and throughout the world;

NOW, THEREFORE, for good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, Assignor hereby sells, assigns and transfers to Assignee, the entire right, title and interest in and to the invention, the applications, and any Letters Patent that might be granted for the invention in the United States and throughout the world, including the right to file foreign applications directly in the name of Assignee and to claim for any such foreign applications any priority rights to which such applications are entitled under international conventions, treaties or otherwise.

Further, Assignor agrees that, upon request and without further compensation, but at no expense to Assignor, he and his legal representatives and assigns will perform all lawful acts, including the execution of papers and the giving of testimony, that might be necessary or desirable for obtaining, sustaining, reissuing or enforcing Letters Patent in the United States and throughout the world for the invention, and for perfecting, recording or maintaining the title of Assignee, its successors and assigns, to the invention, the applications, and any Letters Patent granted for the invention in the United States and throughout the world.

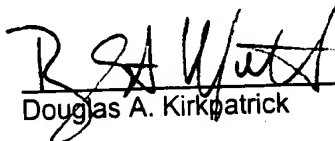
Assignor represents and warrants that he has not granted and will not grant to others any rights inconsistent with any of the terms, conditions, or provisions of this Assignment.

Assignor authorizes and requests the Commissioner of Patents and Trademarks of the United States and of all foreign countries to issue any Letters Patent granted for the invention, whether on the applications or on any subsequently filed division, continuation, continuation-in-part or reissue application, to Assignee, its successors and assigns, as the assignee of the entire interest in the invention.

IN WITNESS WHEREOF, Assignor has executed this Assignment.

Assignor

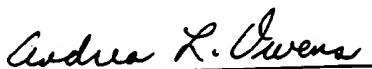
Date: 7 February 2002


Douglas A. Kirkpatrick

State of MARYLAND)
County of MONTGOMERY) ss.

On this 7th day of FEBRUARY, in the year of 2002, before me personally appeared **DOUGLAS A. KIRKPATRICK**, personally known to me or proved to me on the basis of satisfactory evidence to be the person whose name is subscribed to this instrument, and acknowledged to me that he executed it.

IN WITNESS WHEREOF, I have hereunto set my hand and affixed my official seal the day and year of this certificate first above written.


Notary Public in and for Said
County and State

ASSIGNMENT

WHEREAS, James J. Hickman (hereinafter "Assignor"), either alone or in combination with others, has invented a Biosensor for Use in Toxicity Assessment and Pharmacological Screening, for which an application for United States Letters Patent has been filed in the United States Patent and Trademark Office and been identified by said Office as Application Number 08/912,033 (hereinafter collectively "Invention"), and believes himself to be a first, original and either sole or joint inventor of said Invention.

WHEREAS, SCIENCE APPLICATIONS INTERNATIONAL CORPORATION, a Delaware corporation, having a place of business at 10260 Campus Point Drive, San Diego, California 92121, as Assignee (hereinafter "Assignee"), is contractually entitled to acquire by formal, recordable assignment Assignor's entire right, title and interest in and to the Invention, and any Letters Patent that might be granted for the Invention in the United States and throughout the world;

NOW, THEREFORE, in acknowledgment of good and valuable consideration, the receipt and sufficiency of which Assignor hereby acknowledges, Assignor hereby sells, assigns and transfers to Assignee, Assignor's entire right, title and interest in and to the Invention, and any Letters Patent that might be granted for the Invention in the United States and throughout the world, including the right to file foreign applications directly in the name of Assignee and to claim for any such foreign applications any priority rights to which such applications are entitled under international conventions, treaties or otherwise.

Further, Assignor agrees that, upon request and without further compensation, but at no expense to Assignor, he and his legal representatives and assigns will perform all lawful acts, including the execution of papers and the giving of testimony, that might be necessary or desirable for, obtaining, sustaining, reissuing or enforcing Letters Patent in the United States and throughout the world for the Invention, and for perfecting, recording or maintaining the title of Assignee, its successors and assigns, to the Invention, the application, and any Letters Patent granted for the Invention in the United States and throughout the world.

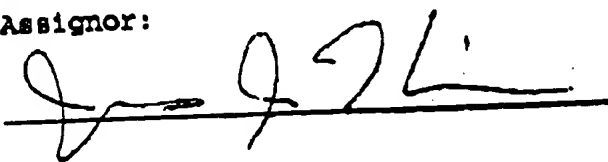
Assignor represents and warrants that he has not granted and will not grant to others any rights inconsistent with the rights granted by this Assignment.

Assignor authorizes and requests the Commissioner of Patents of the United States and of all foreign countries to issue any Letters Patent granted for the Invention, whether on the pending application referenced above or any subsequently filed division, continuation, continuation-in-part or reissue application, to Assignee, its successors and assigns, as the assignee of Assignor's entire interest in the Invention.

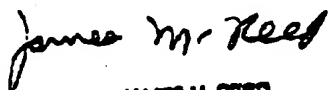
IN WITNESS WHEREOF, Assignor has executed this Assignment.

Assignor:

Date: 2-2-98



[Agreement must be executed in the presence of a Notary Public]



JAMES M. REED
Notary Public District of Columbia
My Commission Expires June 30, 2002

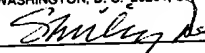
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: James J. Hickman, et al.
Serial No. 09/880,138
Filed: June 12, 2001
For: Biosensor For Use In Toxicity Assessment and
Pharmacological Screening
Examiner: Unassigned

BOX MISSING PARTS
Assistant Commissioner for Patents
Washington, D. C. 20231

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED
WITH THE UNITED STATES POSTAL SERVICE AS FIRST CLASS MAIL IN AN
ENVELOPE ADDRESSED TO BOX MISSING PARTS, THE ASSISTANT COMMISSIONER FOR
PATENTS WASHINGTON, D. C. 20231, ON FEBRUARY 11, 2002

BY


SHIRLEY DOW

**STATEMENT OF MICHAEL B. LACHUK IN SUPPORT OF RENEWED PETITION
FOR REVIVAL OF APPLICATION FOR PATENT ABANDONED
UNINTENTIONALLY UNDER 37 CFR § 1.137(b)**

I, Michael B. Lachuk, declare as follows:

1. At all times relevant, I served as Science Application International Corporation's ("SAIC") Senior Intellectual Property Counsel and have personal knowledge of the statements set forth below.
2. I am the in-house counsel at SAIC responsible for the supervision of all patent, copyright and trademark prosecution and protection that is undertaken on behalf of SAIC.
3. Dr. David Stenger is an employee of the United States Government. I am informed and believe that Dr. Stenger's inventive contribution to the above-referenced application was made in the performance of a contract between SAIC and the United States Government. I am further informed and believe that Dr. Stenger had and still has an obligation to assign to the United States Government his ownership interest in any inventions conceived or first actually reduced to practice during the course of his performance on this Government contract.
4. Pursuant to the standard intellectual property provisions of this Government contract, SAIC has the right to prosecute and pursue an application for a patent for this invention on behalf of itself and the United States Government, subject to the Government retaining an undivided co-ownership interest in any resulting letters patent.

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statement may jeopardize the validity of this document, declares that he/she is properly authorized to execute this document on behalf of the owner; and all statements made of his/her

own knowledge are true and that all statements made on information and belief are believed to be true.

Executed this 8 day of February, 2002.

By: Michael B. Lachuk
Michael B. Lachuk, Esq.
Deputy General Counsel
Director Intellectual Property Law Group
Science Application International Corporation

SIDLEY AUSTIN BROWN & WOOD
A PARTNERSHIP INCLUDING PROFESSIONAL CORPORATIONS

CHICAGO
DALLAS
NEW YORK
SAN FRANCISCO
SEATTLE
WASHINGTON, D.C.

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FACSIMILE 213 896 6600
www.sidley.com
FOUNDED 1866

BEIJING
HONG KONG
LONDON
SHANGHAI
SINGAPORE
TOKYO

WRITER'S DIRECT NUMBER
(213) 896-6053

WRITER'S E-MAIL ADDRESS
mmizrahi@sidley.com

November 9, 2001

VIA CERTIFIED MAIL: Restricted Delivery

Dr. David A. Stenger
CODE 6910
Naval Research Laboratory
Washington, D.C. 20375

Re: U.S. Patent Application for
BIOSENSOR FOR USE IN TOXICITY ASSESSMENT AND
PHARMACOLOGICAL SCREENING
Serial Nos.: 09/880,138 and 09/928,708
Inventors: James J. Hickman, Douglas G. Kirkpatrick
and David A. Stenger
Our Ref. No. 18805-81106 and 18805-81052

Dear Dr. Stenger:

It was a pleasure speaking with you regarding the above-identified patent application. As I mentioned during our telephone conference, I am one of the attorneys for Science Applications International Corporation ("SAIC") responsible for prosecuting the above-identified patent application.

During our telephone conference, you asked that we provide you with a copy of the application, after which you would make a determination as to whether you would execute the paperwork necessary to facilitate the prosecution of this application. Accordingly, we are enclosing a copy of the application, the Declaration, and the Assignment for your review.

Because of time constraints, we filed the application without an inventor(s)' Declaration and Assignment, (part of what is collectively known as "formal papers").

As we anticipate the *Notice of Missing Parts* from the United States Patent and Trademark Office ("USPTO"), we will need to file formal papers by no later than **November 20, 2001**. Therefore, we have prepared and enclose a copy of the application as filed, along with an original and one copy of an Inventor Declaration for each inventor's signatures. Of course, you will be signing on behalf of yourself. You will notice that there are two iterations of the

Dr. David A. Stenger

November 9, 2001

Page 2

Inventor(s) Declaration concerning this application. This is a result of the fact that this case has been pending for some time and the fact that the USPTO is processing the application in duplicate, giving rise to two application numbers assigned to the identical invention. As you can see, aside from the different application numbers, the two pending "Biosensor" applications are identical in all respects. At some point, the USPTO will elect to proceed with only one of them. Until that time, we have no choice but to prosecute both. If you have any questions regarding this matter, please do not hesitate to call me.

Although we have not independently confirmed your inventorship, we are operating under this understanding, in light of the fact that your name appears on the original application as one of the inventors. If you do not believe that you are one of the inventors, then please indicate to us as much in writing.

Please review the application for accuracy and completeness. It is essential to ensure that the application completely describes the best mode each inventor knows for carrying out the invention and to ensure that it is sufficiently detailed to teach one of ordinary skill in the art to make and use the invention. Also, you should read the claims carefully to ensure that they cover all known alternative embodiments of the invention and are not otherwise unduly limiting.

Please keep in mind that the Declaration contains an acknowledgment of the duty as an inventor to disclose all information of which each is aware that is material to examination of the application. This is a continuing duty which does not terminate upon filing of the application.

If it is believed that any changes are necessary in the disclosure or the claims, please let me know. For these changes, it may be possible to file a preliminary amendment before a first office action by the USPTO.

Once you have reviewed the application and confirmed that it complies with the foregoing, please refer to page 3 of each Declaration, fill in your complete residence address (a USPTO requirement), verify your citizenship, then sign and date the Declaration. If any of the information provided must be corrected, then please white-out the incorrect information and type-in the correct information.

Also enclosed is an original and one copy of an Assignment of the invention. Please complete your residence address on the first page of the original Assignment, sign and date as indicated using the same date as the patent Declaration and have your signature notarized. Please return the executed originals of the Declaration and notarized Assignment to us in the pre-paid, self-addressed FedEx envelope enclosed for your convenience.

As I am sure you can appreciate, the application is highly confidential and neither it nor the information embodied therein may be disclosed to third parties.

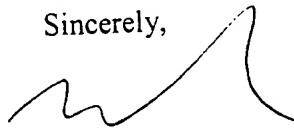
Dr. David A. Stenger
November 9, 2001
Page 3

We look forward to your prompt response as we are operating on a short deadline in which to file these papers with the USPTO.

In addition, as we have to date been unable to locate Dr. Douglas Kirkpatrick's whereabouts, we would appreciate your providing us with contact information for him, if you know. He also is required to execute these materials.

We thank you in advance for your anticipated cooperation in this matter.

Sincerely,



Mark B. Mizrahi

MBM:shd

Enclosures:

- Copy of the applications, with Preliminary Amendment
- Original and one copy of Declarations
- Original and one copy of Assignment
- Pre-paid, self-addressed FedEx envelope

Docket No.
18805-81106

Declaration For Patent Application

English Language Declaration

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name,

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled

BIOSENSOR FOR USE IN TOXICITY ASSESSMENT AND PHARMACOLOGICAL SCREENING

the specification of which

(check one)

☐ is attached hereto.

☒ was filed on JUNE 12, 2001 as United States Application No. or PCT International

Application Number 09/880,138

and was amended on n/a

(if applicable)

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose to the United States Patent and Trademark Office all information known to me to be material to patentability as defined in Title 37, Code of Federal Regulations, Section 1.56.

I hereby claim foreign priority benefits under Title 35, United States Code, Section 119(a)-(d) or Section 365(b) of any foreign application(s) for patent or inventor's certificate, or Section 365(a) of any PCT International application which designated at least one country other than the United States, listed below and have also identified below, by checking the box, any foreign application for patent or inventor's certificate or PCT International application having a filing date before that of the application on which priority is claimed.

Prior Foreign Application(s)

Priority Not Claimed

n/a

(Number)

n/a

(Country)

n/a

(Day/Month/Year Filed)

☐

(Number)

(Country)

(Day/Month/Year Filed)

☐

(Number)

(Country)

(Day/Month/Year Filed)

☐

I hereby claim the benefit under 35 U.S.C. Section 119(e) of any United States provisional application(s) listed below:

n/a

(Application Serial No.)

n/a

(Filing Date)

(Application Serial No.)

(Filing Date)

(Application Serial No.)

(Filing Date)

I hereby claim the benefit under 35 U. S. C. Section 120 of any United States application(s), or Section 365(c) of any PCT International application designating the United States, listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States or PCT International application in the manner provided by the first paragraph of 35 U.S.C. Section 112, I acknowledge the duty to disclose to the United States Patent and Trademark Office all information known to me to be material to patentability as defined in Title 37, CFR Section 1.56 which became available between the filing date of the prior application and the national or PCT International filing date of this application:

SEE EXHIBIT A

(Application Serial No.)

(Filing Date)

(Status)
(patented, pending, abandoned)

(Application Serial No.)

(Filing Date)

(Status)
(patented, pending, abandoned)

(Application Serial No.)

(Filing Date)

(Status)
(patented, pending, abandoned)

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Full name of sole or first inventor JAMES J. HICKMAN	Date
Sole or first inventor's signature	
Residence 125 GRAND OAKS CIRCLE, PENDLETON, S.C., 29670	
Citizenship U.S.A.	
Post Office Address Same as above	

Full name of second inventor, if any DOUGLAS G. KIRKPATRICK	Date
Second inventor's signature	
Residence	
Citizenship U.S.A.	
Post Office Address Same as above	

Full name of third inventor, if any DAVID A. STENGER	Date
Third inventor's signature	
Residence	
Citizenship U.S.A.	
Post Office Address Same as above	

Full name of fourth inventor, if any	Date
Fourth inventor's signature	
Residence	
Citizenship	
Post Office Address	

APPLICATION

for

UNITED STATES LETTERS PATENT

on

**BIOSENSOR FOR USE IN TOXICITY ASSESSMENT
AND PHARMACOLOGICAL SCREENING**

by

JAMES J. HICKMAN, DOUGLAS G. KIRKPATRICK, AND DAVID A. STENGER

18810-81106

Sheets of Drawings: 5

Attorneys

SIDLEY AUSTIN BROWN & WOOD

555 West Fifth Street

Los Angeles, California 90013-1010

Ofc: 213/896-6000

Fax: 213/896-6600

CERTIFICATE OF MAILING BY EXPRESS MAIL, LABEL NUMBER: EL 773 915 763 US

DATE OF DEPOSIT: JUNE 12, 2001

I HEREBY CERTIFY THAT THIS PAPER OR FEE IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE
"EXPRESS MAIL POST OFFICE TO ADDRESSEE" SERVICE UNDER 37 CFR 1.10 ON THE DATE INDICATED ABOVE AND IS
ADDRESSED TO BOX DAC, ASSISTANT COMMISSIONER FOR PATENTS, WASHINGTON, D. C. 20231.

SHIRLEY DOW

(PRINTED NAME OF PERSON MAILING PAPER OR FEE AND SIGNATURE)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: James J. Hickman, Douglas A. Kirkpatrick, and David A. Stenger
Serial No. 09/880,138
Filed: June 12, 2001
For: Biosensor For Use In Toxicity Assessment and Pharmacological Screening
Examiner: Unassigned

BOX MISSING PARTS Assistant Commissioner for Patents Washington, D. C. 20231	CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8
	<small>I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST CLASS MAIL IN AN ENVELOPE ADDRESSED TO BOX MISSING PARTS, ASSISTANT COMMISSIONER FOR PATENTS, WASHINGTON, D.C., 20231 ON 02/11/02</small> BY <u>Shirley Dow</u> SHIRLEY DOW February 11, 2002 Date of Signature

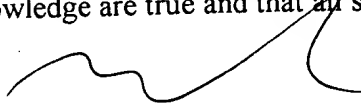
**DECLARATION OF MARK B. MIZRAHI IN SUPPORT OF PETITION TO FILE
DECLARATION FOR PATENT APPLICATION BY JOINT INVENTOR ON BEHALF
OF NONSIGNING INVENTORS, AND STATEMENT OF FACTS IN SUPPORT
THEREOF, UNDER 37 CFR § 1.47(a)**

I, Mark B. Mizrahi, declare:

1. I am an associate with the law firm of Sidley Austin Brown & Wood LLP, acting on behalf of Science Applications International Corporation ("SAIC") in the above-matter.
2. This Declaration is provided in support of SAIC's Petition To File Declaration By Joint Inventor On Behalf Of Nonsigning Inventor Who Refuses to Sign, And Statement Of Facts In Support Thereof, Under 37 CFR § 1.47(a).
3. Prior to the filing of this application, I made various efforts to locate Dr. Stenger, including performing/commissioning an extensive Internet search, wherein it was determined that he was a United States Naval Research Laboratory employee. Soon after having located and contacted Dr. Stenger, by letter dated November 9, 2001 addressed to Dr. Stenger via Certified Mail with return receipt, I provided Dr. Stenger with a true and complete copy of the subject patent application, and the requisite 37 CFR 1.63 inventors' declaration for his execution. (See Exhibit C to the Petition). On or about November 10, 2001, I called Dr. Stenger by telephone, informing him that he should expect to receive the materials via Certified Mail. Dr. Stenger stated that he would review the materials and would promptly respond. Not having heard back from Dr. Stenger, on December 3, 2001, I left a voicemail for Dr. Stenger inquiring into the status of the paperwork. Dr. Stenger responded the following morning by telephone, stating that he had not received the November 9, 2001 letter and enclosures and asked that they be re-sent.

4. On December 4, 2001, I re-sent the November 9, 2001 letter and enclosures to Dr. Stenger, this time via Federal Express. (See Exhibit E to Petition). Via teleconference on December 20, 2001, Dr. Stenger informed me that he declines to participate in the prosecution of the application. Later that same day, Dr. Stenger confirmed this in writing and specifically declined to execute the 37 CFR 1.63 Inventors Declaration. (See Exhibit F to Petition).

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statement may jeopardize the validity of this application or any patent issued thereon, declares that all statements made of his own knowledge are true and that all statements made on information and belief are believed to be true.



Signature

Mark B. MIZRAHI

Typed or Printed Name

2/11/02

Date

SIDLEY AUSTIN BROWN & WOOD
A PARTNERSHIP INCLUDING PROFESSIONAL CORPORATIONS

CHICAGO
DALLAS
NEW YORK
SAN FRANCISCO
SEATTLE
WASHINGTON, D.C.

555 WEST FIFTH STREET
LOS ANGELES, CALIFORNIA 90013
TELEPHONE 213 896 6000
FACSIMILE 213 896 6600
www.sidley.com
FOUNDED 1866

BEIJING
HONG KONG
LONDON
SHANGHAI
SINGAPORE
TOKYO

WRITER'S DIRECT NUMBER
(213) 896-6053

WRITER'S E-MAIL ADDRESS
mmuzrahi@sidley.com

November 9, 2001

VIA CERTIFIED MAIL: Restricted Delivery

**RESENT ON 12/04/01
VIA FEDEX AT
ADDRESSEE'S REQUEST**

Dr. David A. Stenger
CODE 6910
Naval Research Laboratory
Washington, D.C. 20375

Re: U.S. Patent Application for
BIOSENSOR FOR USE IN TOXICITY ASSESSMENT AND
PHARMACOLOGICAL SCREENING
Serial Nos.: 09/880,138 and 09/928,708
Inventors: James J. Hickman, Douglas G. Kirkpatrick
and David A. Stenger
Our Ref. No. 18805-81106 and 18805-81052

Dear Dr. Stenger:

It was a pleasure speaking with you regarding the above-identified patent application. As I mentioned during our telephone conference, I am one of the attorneys for Science Applications International Corporation ("SAIC") responsible for prosecuting the above-identified patent application.

During our telephone conference, you asked that we provide you with a copy of the application, after which you would make a determination as to whether you would execute

Facilitate the prosecution of this application. Accordingly, we are

declaration, and the Assignment for your review.
s, we filed the application without an inventor(s) at is collectively known as "formal papers").

of Missing Parts from the United States Patent and need to file formal papers by no later than **November 20**, enclose a copy of the application as filed, along with an declaration for each inventor's signatures. Of course, you ou will notice that there are two iterations of the

U.S. Postal Service
CERTIFIED MAIL RECEIPT
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OFFICIAL USE

Postage	\$ 3.45
Certified Fee	2.10
Return Receipt Fee (Endorsement Required)	1.50
Restricted Delivery Fee (Endorsement Required)	3.20
Total Postage & Fees	\$ 10.75

Sent To: Dr. David A. Stenger
Street, Apt. No., or PO Box No.: Code 6910, US Naval Research Lab
City, State, ZIP+4: WASH D.C. 20375

PS Form 3800, June 2000

Docket No.

18805-81106

Declaration For Patent Application

English Language Declaration

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name,

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled

BIOSENSOR FOR USE IN TOXICITY ASSESSMENT AND PHARMACOLOGICAL SCREENING

the specification of which

(check one)

☐ is attached hereto.

☒ was filed on JUNE 12, 2001 as United States Application No. or PCT International

Application Number 09/880,138

and was amended on n/a

(if applicable)

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose to the United States Patent and Trademark Office all information known to me to be material to patentability as defined in Title 37, Code of Federal Regulations, Section 1.56.

I hereby claim foreign priority benefits under Title 35, United States Code, Section 119(a)-(d) or Section 365(b) of any foreign application(s) for patent or inventor's certificate, or Section 365(a) of any PCT International application which designated at least one country other than the United States, listed below and have also identified below, by checking the box, any foreign application for patent or inventor's certificate or PCT International application having a filing date before that of the application on which priority is claimed.

Prior Foreign Application(s)

Priority Not Claimed

n/a

(Number)

n/a

(Country)

n/a

(Day/Month/Year Filed)

☐

☐

☐

(Number)

(Country)

(Day/Month/Year Filed)

(Number)

(Country)

(Day/Month/Year Filed)

APPLICATION

for

UNITED STATES LETTERS PATENT

on

**BIOSENSOR FOR USE IN TOXICITY ASSESSMENT
AND PHARMACOLOGICAL SCREENING**

by

JAMES J. HICKMAN, DOUGLAS G. KIRKPATRICK, AND DAVID A. STENGER

18810-81106

Sheets of Drawings: 5

**Attorneys
SIDLEY AUSTIN BROWN & WOOD
555 West Fifth Street
Los Angeles, California 90013-1010
Ofc: 213/896-6000
Fax: 213/896-6600**

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DATE OF DEPOSIT: JUNE 12, 2001

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ADDRESSED TO BOX DAC, ASSISTANT COMMISSIONER FOR PATENTS, WASHINGTON, D. C. 20231.

SHIRLEY DOW

(PRINTED NAME OF PERSON MAILING PAPER OR FEE AND SIGNATURE)

Mizrahi, Mark B.

From: Dave Stenger [dstenger@ccsalph4.nrl.navy.mil]
Sent: Thursday, December 20, 2001 2:24 PM
To: Mizrahi, Mark B.
Subject: RE: Biosensor for use....: 18805-81052 & 81106

Mark,

Yes. My previous message indicates that I will not be executing the Inventor's Declaration that you provided.

Hope this clarifies.

Dave

-----Original Message-----

From: Mizrahi, Mark B. [mailto:MMizrahi@Sidley.com]
Sent: Thursday, December 20, 2001 5:01 PM
To: 'dstenger@cbmse.nrl.navy.mil'
Subject: RE: Biosensor for use....: 18805-81052 & 81106

Dear Dr. Stenger:

Thank you for your response. I would like to clarify your statement that you have elected "to not pursue any prosecution of the application." Does this mean that you will not execute the Inventors' Declaration which we provided to you?

We thank you in advance for your prompt response.

Sincerely,

Mark B. Mizrahi
Sidley Austin Brown & Wood
555 West Fifth St. 40th Floor
Los Angeles, Ca. 90013
Direct Telephone No 213-896-6053
General Telephone No. 213-896-6000
Facsimile No 213-896-6600
e-mail: mmizrahi@sidley.com

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> -----Original Message-----
> From: Dave Stenger [SMTP:dstenger@ccsalph4.nrl.navy.mil]
> Sent: Thursday, December 20, 2001 1:20 PM
> To: mmizrahi@sidley.com
> Cc: Joseph J. Pancrazio PhD
> Subject: Biosensor for use...
>
>
> Mr. Mark B. Mizrahi
> Sidney, Austin, Brown and Wood

> 555 W. Fifth Street, Suite 4000
> Los Angeles, CA 90013
>
>
> Mark,
>
> Thank you for sending me the documents related to our prior patent
> application BIOSENSOR FOR USE IN TOXICITY ASSESSMENT AND PHARMACOLOGICAL
> SCREENING (James J. Hickman, Douglas G. Kirkpatrick, and David A.
> Stenger).
>
> Upon review of that documentation, I have concluded that it would be in
> the
> best interests of the Naval Research Laboratory to not pursue any
> prosecution of the application. Therefore, I am advising you that it is my
> decision not to sign the assignment document and to relinquish all
> interests
> in the application to SAIC and those authors who have elected to respond
> to
> your requests.
>
> Please let me know if I can be of further assistance.
>
> Dave
>
> David A. Stenger, Ph.D.
> Head, Laboratory for Biosensors
> and Biomaterials, Code 6910
> Naval Research Laboratory
> Washington, DC 20375
> tel 202 404 6035
> fax 202 767 0391
>

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: James J. Hickman, et al.
Serial No. 09/880,138
Filed: June 12, 2001
For: BIOSENSOR FOR USE IN TOXICITY ASSESSMENT AND
PHARMACOLOGICAL SCREENING
Examiner: Unassigned

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Washington, D. C. 20231

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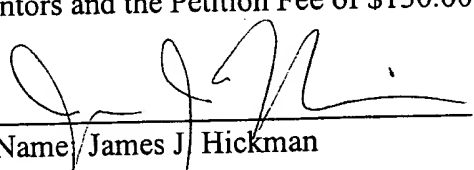
SHIRLEY DOW

**ADDED PAGE TO DECLARATION FOR PATENT APPLICATION BY JOINT
INVENTOR ON BEHALF OF NONSIGNING INVENTORS WHO REFUSE TO SIGN
OR CANNOT BE REACHED (37 C.F.R. §1.47(a))**

1. I am an above-named joint inventor and have signed this declaration on my own behalf and also sign this declaration under 37 C.F.R. 1.47(a) on behalf of the non-signing joint inventors, the particulars for whom are:
 - A. The non-signing joint inventors last known addresses are as follows:

Dr. David A. Stenger
CODE 6910
Naval Research Laboratory
Washington, D.C. 20375

Dr. Douglas A. Kirkpatrick
10929 Beach Mill Road
Great Falls, VA 22066
 - B. Country of Citizenship: I am informed and believe that Drs. Stenger and Kirkpatrick are United States citizens.
2. Accompanying this Declaration is A Petition and Statement of Facts in Support of Filing on Behalf of Non-signing Inventors and the Petition Fee of \$130.00 (37 CFR 1.17(h)).

Dated: 1-31-02
Name: James J. Hickman